

REMARKS

In view of the concurrently submitted declaration by the attorney who filed the pending application, Michael Pavento, along with the previously submitted 37 C.F.R. § 1.131 declaration of the inventor, Stephen Appling, as well as the below remarks, the Applicant asserts that both conception and reasonable diligence to reduce the invention to practice have now been fully shown. Specifically, the submitted declaration of Attorney Michael Pavento and its referenced exhibits provide evidence of the diligence performed by those preparing the above-referenced patent application during time period in question (i.e., November 11, 2000 to December 22, 2000). The Applicant asserts that the amount of time taken to prepare and file the Applicant's patent application was both understandable and reasonable. As a result, the Applicant respectfully asserts that the rejections to the pending claims are now moot, and the pending claims are in condition for allowance.

Declaration of Attorney Michael Pavento

In the Office Action, each of the pending Claims 1-5, 7-11, 13, and 16-21 were rejected under 35 U.S.C. §103(a) as obvious in view of the combination of two patents, U.S. Patent No. 6,823,359 to et al. ("*Heidingsfeld*"), and U.S. Patent No. 6,157,943, to Meyer ("*Meyer*"). In response to a previous Office Action, a second declaration by the inventor, Stephen Charles Appling, made under 37 C.F.R. § 1.131 was submitted. In that declaration, Mr. Appling establishes not only invention of the subject matter of the pending claims prior to the earliest filing date of the *Heidingsfeld* reference, but also reasonable diligence in preparing the 09/747,366 patent application ("the '366 application") for filing with the USPTO from a date just prior to the effective date of the *Heidingsfeld* reference until the filing of the '366 application (i.e., constructive reduction to practice).

Despite the evidence of both conception and diligence provided by the inventor's declaration, the Examiner has requested information explaining the attorney's diligence in preparing and filing the patent application because without such explanation the "evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the *Heidingsfeld* et al. reference to . . . a constructive reduction to practice." (*See* Office Action of January 3, 2007, pages 2). Specifically, the inventor's declaration previously

submitted “provides a first email evidence B(1), emailed on 11/10/2000, but then does not specify what was done by either the Applicant or the Attorney in the gap extending past the effective date of the Heidingsfeld reference, to the second email evidence B(2), emailed on 12/11/2000. This gap is over a month’s time and is of it self evidence that the Applicant/Attorney was not diligent in preparing the application.” (See Office Action of January 3, 2007, pages 2-3).

As a result of the above Examiner statements regarding a lack of evidence for due diligence in preparing the patent application, the Applicant hereby submits a declaration of Attorney Michael Pavento with supporting exhibits to provide further clarification regarding the events that occurred between the correspondence of November 10, 2000 and December 11, 2000, or more importantly, the events that happened at least just before November 21, 2000 (i.e., the priority date of *Heidingsfeld*) through December 22, 2000.

According to the declaration of Attorney Michael Pavento, Mr. Pavento was tasked with revising a previous version of the above-referenced patent application as well as another application for the same client, Automated Logic Corporation, in mid-November of 2000. As shown in the billing records of Exhibit A, for the dates between November 15, 2000 and December 1, 2000, the billing entries refer to the two applications as either the “first application” or “second application.” According to the narrative in the billing entries of Exhibit A, Attorney Michael Pavento worked on revising the “first” application on at least November 20th, 27th, 28th, 29th, 30th and December 1st. Attorney Michael Pavento also worked on revising the “second” application on at least November 15th, 20th, 21st, 27th and 28th. The Applicant’s respectfully assert that regardless of whether the “first application” or the “second application” was the draft of the ‘366 Application, either is sufficient evidence of reasonable diligence between November 15, 2000 and December 1, 2000.

After December 1, 2000, a couple billing entries refer to the two applications as “Color Palette” (on December 3rd) and “IFRAME” (on December 8th). As stated in the declaration of Attorney Michael Pavento, the IFRAME application corresponds to this pending application (the ‘366 application). Moreover, the IFRAME reference in the billing entry of December 8th is associated with billing matter No. “15555-0017.” This matter number is used to refer to the

billing entries for December 8th, 11th, and 22nd. This pending application was filed on December 22, 2000, which is consistent with the final billing entry listed in Exhibit A.

In the partially unredacted correspondence of December 11, 2000 from Attorney Michael Pavento included as Exhibit B, Mr. Pavento indicates that his changes to the draft of the '366 patent application were "pretty significant." From the email of December 11, 2000 and December 22, 2000, we can see that the time between the night of December 12, 2000 and the morning of December 22, 2000 was provided for the inventor to review and consider the revised draft of the patent application.

In the partially unredacted correspondence of December 22, 2000 of Exhibit B, both the attorney and the inventor transmitted their comments for the other's review, both making their suggestions to modify particular areas of the draft of the '366 patent application. Mr. Pavento's email of December 22, 2000 indicated that the application was revised per the inventors comments and more claims were added at the end of the application. At the end of the inventors correspondence, the inventor finally indicated that the application was in final form, specifically stating "Rest of it looks great." The application was then promptly filed on that same day, December 22, 2000.

Therefore, during the time period in question (i.e., November 11, 2000 to December 22, 2000), "significant" revisions to the draft of the patent application were conducted. The amount of time taken to prepare and file the Applicant's patent application was both understandable and reasonable. For at least the reasons stated above, the Applicant asserts that reasonable diligence was undertaken by both the inventor and patent attorney in preparing and filing the pending patent application from a time just prior to November 21, 2000 through December 22, 2000. As a result, the *Heidingsfeld* reference is not considered sufficient prior art to be used in combination with the *Meyer* reference to render the current claims unpatentable under 35 U.S.C. §103(a). For at least these reasons, the combination of *Heidingsfeld* and *Meyer* fails to render the pending claims unpatentable. Thus, the arguments presented in the Office Action are now moot. Therefore, the Applicant asserts that Claims 1-5, 7-11, 13, and 16-21 are in condition for allowance.

In re: Appling
Appl. No.: 09/747,366
Filed: December 22, 2000

Conclusion

The foregoing is submitted as a full and complete response to the Office Action. The Applicant requests that all the pending claims be allowed because they are patentable over the art of record. It is therefore respectfully requested that a Notice of Allowance be issued. If there are any issues that can be resolved by a telephone conference or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney at (404) 853-8253.

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



William T. Cook
Registration No. 58,072

Date: May 3, 2007
SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
(404) 853-8253
(404) 853-8806 (fax)
SAB Docket No.: 15555-0020